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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,557	12/27/2001	Yoshiko Akazawa	1083.1084	9898
21171 7590 06/17/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER CHANKONG, DOHIM	
			ART UNIT 2152	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/026,557

Applicant(s)

AKAZAWA ET AL.

Examiner

DOHM CHANKONG

Art Unit

2152

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,10,12-14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10,12,13,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 6 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/29/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- 1> This action is in response to Applicant's request for continued examination. Claims 1, 2, 10, 12, and 17 are amended. Claims 9 and 16 are canceled. Claims 1, 2, 4, 6, 10, 12-14, 17 and 18 are presented for further examination.
- 2> This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

- 3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2.26.2008 has been entered.

Allowable Subject Matter

- 4> Claims 6 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

- 5> Applicant's arguments with respect to claims 1, 2, 4, 6, 9, 10, 12-14, and 16-18 have been considered but are not considered persuasive. Applicant argues that Karaev does not teach

“accepting, by one terminal device directly connected to the said central apparatus, as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient, the provision format including a portable document format that is non-modifiable...and an original format which is modifiable...” (emphasis removed).

It should first be noted that Applicant's specification is silent as to what is meant by "directly connected to said central apparatus." Thus, the limitation is given its broadest reasonable interpretation consistent with Applicant's specification. Based on Applicant's arguments, the limitation is intended to refer to a direct network connection between the terminal and the central apparatus. However, Applicant's specification suggest otherwise. According to Applicant's specification and figures, terminal devices may be connected to the central apparatus through a firewall computer [Figure 1 «item 4»]. Therefore, the terminal devices are not “directly” connected to the central apparatus but instead through a firewall computer.

Based on Applicant's specification, one of ordinary skill in the art would have interpreted the limitation “directly connected to said central apparatus” as merely being connected over the network to the central apparatus as seen in Applicant's figure 1. There is no other description in Applicant's specification with respect to the limitation.

As to the cited prior art references, Applicant asserts that Karaev teaches a central repository server that receives document profiles with information relating to each research document including authorization information specifying who is permitted to access each research document. However, Applicant' does not explain why this teaching is different

from the new limitation. Karaev's central repository server reads on Applicant's claimed central apparatus. Karaev also teaches terminal devices directly connected to the central repository over a network [Figure 1]. Therefore, Karaev teaches the new limitation as claimed.

Applicant also argues that the secondary reference Beaulieu does not teach "a portable document format that is non-modifiable and is converted from said provision information at the terminal device." In support of this argument, Applicant asserts that Beaulieu teaches a user inputting investment research into the author station prior to conversion to the PDF format. Applicant's arguments are not persuasive because Beaulieu was not relied upon to teach a terminal device providing provision information. Beaulieu was only relied upon to teach a client converting documents to PDF format prior to uploading the documents to a server [column 4, line 55 through column 5, line 6].

Finally, Applicant argues that there is no motivation to combine the cited references. Applicant bases this argument on Karaev's teaching of converting documents at a central site. However, Beaulieu provides motivation to modify this arrangement so that the conversion takes place at the client device prior to uploading the documents to the central site. According to Beaulieu, rendering documents into PDF format at the client guarantees that documents will be stored at the server in their original form [column 3 «lines 14-23» | column 4 «lines 60-66»]. Thus, one of ordinary skill in the art would have been motivated to adapt Karaev with Beaulieu's teachings to insure that documents are preserved in their original form.

Based on the foregoing, Applicant's arguments are not persuasive. Therefore, the rejections set forth in the previous action are maintained. However, as indicated above, the rejection of claims 6 and 14 are withdrawn as they contain allowable subject matter. If the limitations of these claims are amended into the independent claims, then prosecution of the instant application will be expedited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6> Claims 1, 2, 9, 10, 12, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev et al. (U.S. Patent Number 5,802,518), hereinafter referred to as Karaev, in view of Beaulieu et al. (U.S. Patent Number 5,502,637), hereinafter referred to as Beaulieu, in further view of Edwards et al, U.S Patent No. 6,834,312 ["Edwards"].

7> Karaev disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, Beaulieu disclosed a system for the distribution of documents that allows the documents to be immediately rendered by users in the author's original form. In an analogous art to both Karaev and Beaulieu, Edwards disclosed a system

for the distribution of documents that allow users to control the level of access to submitted documents.

8> Concerning claims 1, 2, 9, 10, 12, 16, and 17, Karaev did not explicitly state the portable document format being converted from the provision information at the terminal device. However, Beaulieu teaches that a document may be converted to a portable document format at a terminal device before the document is sent to a central server. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Karaev by adding the ability to convert to the portable document format from the provision information at the terminal device as provided by Beaulieu. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

9> Also concerning claims 1, 2, 9, 10, 12, 16, and 17, Karaev as modified by Beaulieu does not disclose providing provision information to a recipient in either a portable document format or the original format that corresponds to the provision format based on the recipient information.

Edwards teaches that a submitted document can be converted to different formats where the user can specify "varying levels of user access to the data" by selecting among a plurality of user viewing rights [column 8 «lines 3-7»]. Of these different formats includes a non-modifiable output file that is provided to those users that are designated as having no

authority to modify the file [column 8 «lines 9-16» | column 11 «lines 17-22» where : PDF is a non-modifiable output file]. Or, if the recipient has more authority, the source file in its original format can be provided [column 8 «lines 23-26»].

Thus, Edwards teaches providing to a recipient the provision information in the portable document format (Edward's non-modifiable output file) or the original format (original source file) based on the recipient information registered in the one set of data (Edwards' specifier requirements). It would have been obvious to one of ordinary skill in the art to modify Karaev's system by adding Edward's varying levels of user access to files. Edwards teaches that such functionality provides needed protection to sensitive information [column 8 «lines 16-20»]. Similar remarks apply to claim 17.

10> Thereby, the combination of Karaev, Beaulieu, and Edwards discloses:

- <Claims 1, 2, 9, 10, 12, and 16>

An information providing method for providing provision information which is to be provided and registered in a central apparatus in response to a request from plural terminal devices which are connected to said central apparatus by a communication network, comprising:

accepting, by one terminal device, as one set of data provision information, recipient information relating to a recipient who is authorized to receive said provision information, and a provision format of said provision information to be applied to said recipient (Karaev, column 6, lines 21-43), the provision format including a portable document format which is converted from provision information

at the terminal device and an original format which is not converted from provision information (Karaev, column 3, lines 34-39 and for conversion at the terminal device Beaulieu, column 4, line 55 through column 5, line 6);

transmitting, by said one terminal device to said central apparatus, the one set of data after said accepting;

registering, in said central apparatus, the one set of data after said transmitting (Karaev, column 6, lines 21-43 | see also Edwards, column 8 «lines 3-26» : storing specifier requirements);

receiving, by said central apparatus, a request and recipient information of a recipient who generated the request transmitted from one of the terminal devices (Karaev, column 11, lines 19-46); and

providing, by said central apparatus to said one of the terminal devices which transmitted the request and the recipient information, the provision information in the portable document format or the original format corresponding to the provision format based on the recipient information registered in the one set of data (Karaev, column 15, line 60 through column 16, line 7 | Edwards, column 8, lines 3-26 – providing provision information in either portable document format or the original format).

- <Claim 17>

A method for providing requested information to authorized recipients, comprising:

receiving, from any user who is authorized to store format information for provision information [Karaev, column 3 «lines 21-28» | Edwards, column 9 «lines 15-

18»], the format information for each authorized recipient of the provision information, the format information indicating at least one provision format selected from among at least an original format and a portable document format [Edwards, column 8 «lines 3-26» : specifier requirements determine which file the recipient receives – non-modifiable (such as PDF) or the source file in its original format or something in between];

storing, as one set of data in computer-readable storage accessible by at least one server, provision information stored in an original format and a portable document format converted from the provision information at a terminal device and accessible by authorized recipients, recipient information indicating what in the provision information each of the authorized recipients is authorized to receive, and format information corresponding to the provision information and the recipient information indicating in what format the provision information can be provided to each of the authorized recipients (Karaev, column 6, lines 21-43 and portable document format at column 3, lines 34-39 and for conversion at the terminal device Beaulieu, column 4, line 55 through column 5, line 6);

receiving, by the at least one server from a requesting terminal device, a request for at least one item of the provision information and a recipient identifier (Karaev, column 11, lines 19-46); and

transmitting, from the at least one server towards the requesting terminal device, requested provision information in a registered provision format if the recipient information indicates that permission to access the requested provision

information in the registered provision format has been granted to the recipient identifier (Karaev, column 15, line 60 through column 16, line 7).

- <Claim 18>

A method as recited in claim 17, further comprising:

receiving, by the at least one server from a providing terminal device, a provider name for a provider of new provision information (Karaev, column 6, lines 29-36); and

accepting, by the at least one server for storage in the computer-readable storage if the provider name is authorized according to the recipient information, the new provision information, authorized recipient information identifying at least one recipient who is authorized to receive the new provision information, and at least one indication of an authorized format in which the new provision information is to be provided to the at least one recipient (Karaev, column 6, lines 21-43), the authorized format including at least the original format of the new provision information and the portable document format converted from the new provision information (Karaev, column 3, lines 34-39 | see also Edwards, column 8 «lines 3-26»).

Since the combination of Karaev, Beaulieu and Edwards discloses all of the above limitations, claims 1, 2, 8-12, and 15-18 are rejected.

11> Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karaev, Beaulieu and Edwards, as applied above, further in view of D'Angelo (U.S. Patent Number 6,717,938).

12> The combination of Karaev, Beaulieu and Edwards disclosed a system for the secure electronic distribution of documents over the world wide web. In an analogous art, D'Angelo disclosed a communications system that allows users to control what elements of their personal information are available by other users via directory servers.

13> Concerning claims 4 and 13, the combination of Karaev and Beaulieu did not explicitly state the accepting, transmitting, registering, or providing steps as including name disclosure information as claimed. However, D'Angelo's system allows a user to decide whether or not his name or other personal information is published on a server. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Karaev, Beaulieu, and Edwards by adding the ability to include name disclosure information in the one set of data so that the accepting, transmitting, registering, and providing steps included the name disclosure information as provided by D'Angelo. Here the combination satisfies the need for an Internet information delivery system that provides information only to users who are authorized to receive it. See Karaev, column 3, lines 3-9. This rationale also applies to those dependent claims utilizing the same combination.

14> Thereby, the combination of Karaev, Beaulieu, Edwards, and D'Angelo discloses:

- <Claims 4 and 13>

The information providing system as set forth in Claim 2, wherein said processor of said one terminal device is further capable of performing an operation of accepting, as part of the one set of data, name disclosure information indicating whether or not a name of provider who provides the provision information to be disclosed; said operation of transmitting further transmitting the name disclosure information as part of the one set of data; said operation of registering further registering the name disclosure information as part of the one set of data; and said operation of providing further providing to the one of said terminal devices which transmitted the request and the recipient information, a name of provider based on the recipient information and the name disclosure information registered in the one set of data (D'Angelo, column 20, lines 3-13).

Since the combination of Karaev, Beaulieu, and D'Angelo discloses all of the above limitations, claims 4 and 13 are rejected.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152